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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/722,685	11/24/2003	Darrell C. Brett	ExpC:EptaWed	8337

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LAW OFFICE OF KAREN DANA OSTER, LLC
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EXAMINER

SHAY, DAVID M

ART UNIT	PAPER NUMBER
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3735

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/27/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/722,685

Applicant(s)

BRETT, DARRELL C.

Examiner

david shay

Art Unit

3735

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on November 13, 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

Art Unit: 3735

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on November 13, 2006 has been entered.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-23 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Lax et al ('242).

See Figures 2, 3, 6-16, 22, and 23 and column 6, line 65 to column 11, line 2. The cross sections of Figures 7 and 10 are considered "dome shaped". Specifically, the edge (element 20) of the embodiment shown in Figures 2 and 3 is described as "radiused" and is thus considered "rounded" as used in the claims. Since the edge is rounded, the distalmost portion (leading edge) is "thin" compared to more proximal portions thereof. The device is designed to be 'easily painted across tissue without "hanging up" on any section of tissue' (see column 6, lines 36-37) and thus is considered "suitable for gliding over surfaces of an annulus fibrosis without snagging" as claimed. The supporting portion of the device that couples to the handle would lift tissue away from the applicator face. The embodiment of Figures 6 and 12 show devices wherein the distal end is "wedge-shaped" as claimed. The embodiments of figures 9 and 10, among others, expressly teach the use of insulation materials and other configurations in order to "minimize damage to tissue areas that are not treated (column 8, lines 8-64, especially lines 10-11). The device is designed to be used on spinal tissue as shown in Figures 22 and 23.

Claims 1, 2, 4-13, 16, 17, 20, 21, 24, and 25 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Underwood et al ('640).

See Figures 20 and 25-28 and column 28, line 55 to column 32, line 49. Specifically, with reference to Figure 28, support tongue (element 420) has a “non-active” insulating side 521 of working end 404” which “minimizes the generation of electric fields on this side 521 to reduce ablation of the adjacent vertebra 542.” (see column 32, lines 17-20) the working end (element 404) is described as “low profile” with “thickness values as low as 0.2 mm” (see column 32, lines 9-10). A thickness of 0.2 mm (200 microns) is considered to fall within the broadest reasonable interpretation of the term “thin” as applicant has provided no particular definition for this term in the originally filed disclosure, although depending on the term for patentability. As can readily be seen from Figure 28, the working end tapers to the thin rounded end, and thus also is considered to be “wedge-shaped” with the electrodes (elements 416) on the opposite side. It can also be seen from the current flow diagrams in Figure 26 that the tissue is protected by element 521 and since the working end is tapered, it will necessarily lift the tissue contacting the element 521 with respect to the tissue contacted by electrodes 416.

The terminal disclaimer filed March 3, 2006 has been approved. Accordingly, the double patenting rejection has been withdrawn.

Applicant's arguments filed November 13, 2006 have been fully considered but they are not persuasive. The arguments are not persuasive for the reasons set forth above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to david shay whose telephone number is (571) 272-4773. The examiner can normally be reached on Tuesday through Friday from 6:30 a.m. to 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Marmor, II, can be reached on Monday, Tuesday, Wednesday, Thursday, and Friday. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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